

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appln No.:	09/881,609)	
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Applicants:	Pedlow, Leo Mark, Jr.)	Confirmation No. 6398
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Art Unit:	2424)	
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Examiner:	SHELEHEDA, James R.)	<u>Jan. 26, 2009</u>
)	Date
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Docket No.:	71713/7114)	

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Commissioner for Patents
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REPLY BRIEF

Dear Sir:

Pursuant to 37 C.F.R. §41.41, the Applicants hereby respectfully submit the following Reply Brief in response to the Examiner's Answer mailed November 25, 2008 in support of the appeal of the final rejection of claims 1-12 and 20-22 in the office action mailed August 22, 2006.

Application No. 09/881,609
REPLY BRIEF
Notice of Appeal dated November 22, 2006
Decision of Primary Examiner dated August 22, 2006

(1) Status of Claims

Claims 1-12 and 20-22 are pending and presently stand thrice and finally rejected and constitute the subject matter of this appeal; and
claims 13-19 and 23-25 have been canceled.

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(2) Ground of Rejection to be Reviewed on Appeal

Issue 1

Claims 1-12 and 20-22 stand rejected under 35 U.S.C. 102(b) given U.S. Patent No. 5,790,935 to Payton (herein referred to as Payton). The applicant disputes these rejections.

Issue 2

Claims 2, 3 and 4 stand objected to due to informalities.

(3) Arguments

Issue 1: Claims 1-12 and 20-22 are Not Anticipated Under 35 U.S.C. §102(b) by U.S. Patent No. 5,790,935 to Payton.

Claims 1-12 and 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Payton, U.S. Patent No. 5,790,935. Applicants respectfully submit that Payton does not expressly or inherently teach each limitation as recited in at least the pending independent claims, and thus, Applicants request the rejections be withdrawn.

3.1 Examiner's assertions under Paragraph (10)(b) of Examiner's Answer

Applicants respectfully submit that the Examiner fails to provide support for the interpretation of Payton and instead simply makes a conclusory statement that is unsupported by Payton.

The Examiner states that Payton “transmits content in two distinct fashions” (Answer, pg. 10), and continues to suggest that a second content that comprises non-requested, recommended content can be defined as dummy sessions (see at least Answer, pg. 11). Regardless of whether the recommended content is considered dummy content or not, Payton does not teach or suggest transmitting the recommended content “to maintain the predetermined minimum bandwidth of content over the transport stream” as recited in claim 1. Nowhere does Payton suggest maintaining a minimum bandwidth of content over a transport stream.

The Examiner continues to suggest on page 12 of the Answer that “[t]he recommended content is utilized to ensure that the bandwidth of content does not fall below the level that there would be bandwidth wasted” (Answer, pg. 12). However, the Examiner does not cite to where Payton describes that “[t]he recommended content is utilized to ensure that the bandwidth of content does not fall below the level that there would be bandwidth wasted” (Id.).

Instead, the Examiner simply makes a conclusory statement that the recommended content is provided so that bandwidth does not fall below a level. There is no discussion or

suggestion in Payton to maintain a minimum level, or to provide content so that the bandwidth does not fall below a level.

In attempts to support this assertion the Examiner only identifies that Payton makes a determination of whether bandwidth is available to transmit content citing column 7, lines 36-41. However, the cited portion does not describe or suggest maintaining a minimum bandwidth. Instead, the cited portion only describes determining whether bandwidth is available. There is nothing in the cited portion to suggest that a minimum bandwidth is maintained. Instead, the cited portion only describes determining whether bandwidth is available when there is content to transmit. In those instances where there is no content to transmit, then no additional content is sent and no minimum bandwidth is maintained.

Applicants further submit that it is not even inherent in Payton that the system “ensure[s] that the bandwidth does not fall below the level that there would be bandwidth wasted” (Answer, pg. 12). To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present ... Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient’ (*In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted), emphasis added; see also MPEP section 2112). The Examiner fails to demonstrate that it is necessarily present that Payton “ensures” that the bandwidth does not fall below a level, and instead only presents a possibility that is not even supported by Payton. Applicants further submit that Payton would not try to “ensure that the bandwidth ... does not fall below the level” (Answer, pg. 12, emphasis removed) as this would require the usage of bandwidth with no apparent benefit in accordance with Payton when at least there is no additional content to be distributed.

Therefore, Applicants respectfully submit that Payton does not expressly or inherently teach each limitation as recited in at least claim 1, and thus, Applicants respectfully request the rejections be withdrawn.

3.2 Examiner's assertions under Paragraph (10)(c) of Examiner's Answer

The Examiner incorrectly interprets Payton suggesting that Payton admits that the system of Payton "would not have enough total bandwidth to service all of the requests" (Answer, pg. 13, citing Payton, col. 4, lines 23-44). Payton does not, however, suggest that there would not be enough total bandwidth to service all of the requests but only describes that systems could not provide real on-demand content at peak times.

The Examiner then further attempts to suggest that Patent "ensures that the total system bandwidth is always being used" (Answer, pg. 14, citing Payton, col. 7, lines 36-41). Again, however, Applicants have demonstrated that Payton does not teach and does not suggestion ensuring the total system bandwidth is always being used as suggested by the Examiner. The cited portion simply states that if there available bandwidth and **if** there is content to transmit that the content will be transmitted with bandwidth available. There is no discussion or suggestion of maintaining a minimum bandwidth. Instead, Payton would not communicate anything if there was no content to communicate regardless of whether bandwidth was available. The Examiner instead, must read part of Applicants invention into Payton in attempts to interpret Payton to read that a minimum bandwidth is maintained.

One cannot equate the use of bandwidth when content is to be transmitted with the maintaining of a minimum bandwidth. When Payton does not have content to transmit, no content is transmitted. Therefore, Payton does not maintain a minimum bandwidth.

Applicants direct the Board to Applicants arguments in the Appeal Brief that more fully demonstrate that Payton does not teach or suggest maintaining a minimum bandwidth. Therefore, Applicants respectfully request the rejections be withdrawn.

3.3 Examiner's assertions under Paragraph (10)(c) of Examiner's Answer

The Examiner again suggests that the recommended content is transmitted to maintain a minimum bandwidth, again relying on column 7, lines 36-41 and suggesting that Payton is "ensuring that the total system bandwidth is always being used" (Answer, pg. 14, emphasis

added). However, Payton never suggests that the system ensure the total system bandwidth is always used. To the contrary, Payton only attempts to minimize the peak demands by distributing recommended content during non-peak times. Further as demonstrated, the portion of Payton cited by the Examiner only states that a determination of available bandwidth is made when additional content is to be transmitted. When no additional content is to be transmitted Payton does not describe maintaining a minimum bandwidth.

Therefore, the Examiner is simply assuming that Payton “ensuring that the total system bandwidth is always being used” (Answer, pg. 14, emphasis added), and the portion of Payton cited by the Examiner does not support the Examiner’s assertion.

Further, it is not even inherent in Payton that the system ensures that the total system bandwidth is always being used, or that a minimum amount of bandwidth is maintained. To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present ... Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient’ (*In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted), emphasis added; see also MPEP section 2112). The Examiner fails to demonstrate that it is necessarily present, and instead presents a possibility that is not even supported by Payton. Applicants further submit that Payton would not try to ensure “that the total system bandwidth is always being used” (Answer, pg. 14, emphasis added) as this would require the usage of bandwidth with no apparent benefit when there was no additional content to be distributed.

Thus, Applicants respectfully request that the rejections be withdrawn.

3.4 Examiner’s assertions under Paragraph (10)(d) of Examiner’s Answer

The Examiner further admits, regarding at least claim 2, that receivers of recommended content are granted access to playback the recommended content. However, claim 2 requires that the dummy sessions are prevented from being decoded by each receiver. Therefore, the

Examiner's arguments support Applicants' arguments and demonstrate that the rejection cannot be maintained.

3.5 Examiner's assertions under Paragraph (10)(e) of Examiner's Answer

Payton also does not describe or suggest "the transmission of the recommended content [that] ensures that the receivers are able to synchronize and display their desired content" as suggested by the Examiner (Answer, pg. 15). Instead, Payton only distributes recommended content to reduce peak demands. This does not ensure synchronization, but instead simply makes the content potentially available. Potential access to content cannot be equated to ensuring synchronization.

Further, this recommended content may not even be desired by a user and thus never accessed. Still further, Payton specifically states that on-demand options are reduced when the bandwidth is full, thus, preventing users from accessing content. Therefore, users cannot access desired content and are thus not synchronized.

3.6 Examiner's assertions under Paragraph (10)(g) of Examiner's Answer

Payton does not discuss encoding the video. Instead, Payton states at col. 4 lines 59-64 that "[t]he digital items are preferably stored in a compressed format to improve storage and transport efficiency. The Motion Picture Entertainment Group (MPEG2) compression algorithm provides approximately two orders of magnitude of video compression while maintaining sufficient signal quality." Payton never mentions an encoder and does not describe encoding the content. Instead, Payton only describes storing content in a "compressed format" in order to "improve storage and transport efficiency" and does not describe encoding the content. Furthermore, the Payton system does not teach an encoder and does not teach or suggest a need for performing any encoding. Applicant submits that the content delivered to the system in Payton is delivered in a compressed and encoded format, and thus, there is no need to encode the

content. Therefore, Payton fails to expressly or inherently teach or suggest an encoder, and thus, claim 6 is not anticipated by Payton.

Further, the Examiner makes the assumption that the system of Payton receives the content in an unencoded state. There is no support for this assertion and Applicants respectfully submit that content would not be provided to an on-demand system in an unencoded state. Payton does not suggest or mention encoding because the system of Payton does not perform any encoding and does not include an encoder. The Examiner does not even suggest that it is inherent that Payton include an encoder because it is not inherent as Payton would not encode the content but instead receive the content in an encoded form. Further, inherency cannot be demonstrated by possibilities (see at least *In re Robertson*). Therefore, the Examiner has failed to demonstrate that Payton expressly or inherently teaches each limitation as recited in claim 6, and thus, the rejection cannot be maintained and Applicants respectfully request that the rejection be withdrawn.

3.7 Examiner's assertions under Paragraph (10)(i) of Examiner's Answer

Applicants have demonstrated in the Appeal Brief that Payton does not describe at least the terminating of the transmission of a recommended content. The portion of Payton cited by the Examiner does not describe or suggest terminating the transmission of recommended content. Again, Applicants direct the Board to Applicants arguments presented in the Appeal Brief.

Specifically, the portion of Payton cited by the Examiner only describes determining whether bandwidth is available and whether an on-demand request queue is empty, and if it is then selecting a recommended content. Nowhere in the cited portion does Payton suggest, and Applicants submit that Payton does not describe or suggest, terminating a transmission of recommended content.

Therefore, Applicants respectfully request the rejection be withdrawn.

3.8 Examiner's assertions under Paragraph (10)(a) of Examiner's Answer

Applicants respectfully submit that Payton does not transmit dummy sessions.

Applicants again direct the Board to the Appeal Brief where Applicants demonstrate that Payton does not transmit dummy sessions, and instead only transmits data that is intended to be used and viewed by recipients. It is the purpose of Payton that such recommended data be used by the recipients in order to reduce the on-demand loads at peak times. If this recommended data is not used, then the entire invention of Payton is made irrelevant and destroys the intended purpose of Payton.

Payton only describes sends content to users that the content provided believes that uses would likely request, and thus, likely access and playback. Therefore, Payton specifically and intentionally identifies a user, identifies content that the use is likely to want and forwards that content to the identified user. Specifically, Payton states that user preferences are tracked in a user profile and identifies content that a specific user is likely interested in receiving, see at least col. 5, lines 6-20. Upon identifying the content, the system forwards the identified content that the system believes the specific use would want.

Applicant respectfully submits that the recommended contents described in Payton are not dummy sessions in at least that recommended items are predicted to be, and sent with the intention that they will be locally stored and viewed by user in a virtual video-on-demand (VOD) system. Additionally, the recommended items in Payton are sent to reduce the amount of bandwidth used by the true VOD system in Payton.

Again, Applicants direct the Board to the Appeal Brief that demonstrates that the recommended items cannot be viewed as dummy sessions as would be clearly understood by one skilled in the art, and further, that Payton does not teach or suggest transmitting dummy sessions. Therefore, Applicants respectfully submit that Payton does not expressly or inherently teach each limitation as recited in at least the independent claims, and thus, Applicants request the rejections be withdrawn.

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Conclusion

Applicants respectfully submit that Payton does not expressly or inherently teach each limitation as recited in the pending claims, and thus, Applicants respectfully request the rejections be withdrawn.

Date: January 26, 2009

Respectfully submitted,

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